

01-31-01

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Patent  
Attorney's Docket No. 033072-007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REQUEST FOR FILING CONTINUATION/DIVISIONAL  
APPLICATION UNDER 37 C.F.R. § 1.53(b)



Box PATENT APPLICATION  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This is a request for filing a ☒ continuation ☐ divisional application under 37 C.F.R. § 1.53(b) of pending Application No. 09/469,554 filed on December 22, 1999, for Inhibition of  $\beta$ -arrestin Mediated Effects Prolongs and Potentiates Opioid Receptor-Mediated Analgesia, which is a continuation in part of Serial No. 09/233,530, filed January 20, 1999, entitled Methods of Assaying Receptor Activity and Constructs Useful in Such Methods, now U.S. Patent No. 6,110,693, issued August 29, 2000, which is a continuation of Serial No. 08/869,568, filed June 5, 1997, entitled Methods of Assaying Receptor Activity and Constructs Useful in Such Methods, now U.S. Patent No. 5,891,646, issued April 6, 1999, by the following named inventor(s):

- (a) Full Name Lawrence S. BARAK
- (b) Full Name Marc G. CARON
- (c) Full Name Stephen S. FERGUSON
- (d) Full Name Jie ZHANG

- ☒ The entire disclosure of the prior application from which a copy of the oath or declaration is supplied herewith is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.
- ☐ This application is being filed by less than all the inventors named in the prior application. In accordance with 37 C.F.R. § 1.63(d)(2), the Commissioner is requested to delete the name(s) of the following person or persons who are not inventors of the invention being claimed in this application.

- (a) Full Name \_\_\_\_\_



21839

☒ This application is being filed by the same inventors that are named in prior applications 09/233,530 and 08/869,568. Accordingly, the following persons are inventors of the invention being claimed in this application:

- (a) Full Name Lawrence S. BARAK
- (b) Full Name Marc G. CARON
- (c) Full Name Stephen S. FERGUSON
- (d) Full Name Jie ZHANG

☐ Applicant(s) hereby request(s) that the above-captioned application **NOT BE PUBLISHED** under 35 U.S.C. § 122(b) and 37 C.F.R. § 1.211. The undersigned hereby certifies that the invention disclosed in this application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

☐ Applicant(s) suggest(s) Figure    for inclusion on the front page of the patent application publication and patent.

1. ☐ Enclosed is a copy of the prior Application No.    as originally filed on   , including copies of the specification, claims, drawings and the executed oath or declaration as filed.
2. ☐ Enclosed is a revised prior application and a copy of the prior executed oath or declaration as filed. No new matter has been added to the revised application.
3. ☒ Small entity status is hereby claimed.
4. ☐ The filing fee is calculated below ☐ and in accordance with the enclosed preliminary amendment:

C L A I M S					
	NO. OF CLAIMS		EXTRA CLAIMS	RATE	FEE
Basic Application Fee				(101)	\$ 710.00
Total Claims	1	MINUS 20 =	0	x \$18 = (103)	0.00

Independent Claims	1	MINUS 3 =	0	x \$80 = (102)	0.00
If multiple dependent claims are presented, add \$270.00 (104)					0.00
Total Application Fee					\$710.00
If small entity status is claimed, subtract 50% of Total Application Fee					\$355.00
Add Assignment Recording Fee of \$40.00 if Assignment document is enclosed					0.00
<b>TOTAL APPLICATION FEE DUE</b>					<b>\$355.00</b>

5. ☒ Charge \$ 355.00 to Deposit Account No. 02-4800 for the fee due.
6. ☐ A check in the amount of \$ \_\_\_\_\_ is enclosed for the fee due.
7. The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.
8. ☐ Cancel in this application original claims \_ of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)
9. ☐ Amend the specification by inserting before the first line the sentence: --This application is a ☐ continuation, ☐ divisional, of Application No. \_\_, filed \_\_--
10. ☒ A set of formal drawings are enclosed for purposes of clarity.
11. ☐ Priority of Application No. \_ filed on \_ in \_ (country) is claimed under 35 U.S.C. § 119.  
☐ The certified copy of the priority application  
☐ is enclosed  
☐ was filed on \_ in prior Application No. \_\_, filed on \_\_, and acknowledged by the Examiner on \_ in Paper No. \_  
☐ has not yet been filed.
12. ☐ A preliminary amendment is enclosed.
13. ☐ An Information Disclosure Statement is enclosed.

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14. ☐ A General Authorization for Payment of Fees and Petitions for Extensions of Time is enclosed.
15. ☒ Also enclosed Letter to the Examiner.
16. ☐ The power of attorney in the prior application is to \_.
- a. ☐ The power appears in the original papers in the prior application.
- b. ☐ Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.
- c. ☐ Recognize as Associate Attorney \_.
- d. ☐ Address all future communications to: (May only be completed by applicant, or attorney or agent of record.)

Allen R. Baum, Esquire  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, Virginia 22313-1404

Jan. 30, 2001  
Date

By: Melissa M. Hayworth  
Melissa M. Hayworth  
Registration No. 45,774

Address of  
signator:

BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

- ☐ inventor(s)  
☐ assignee of complete interest  
☒ attorney or agent of record  
☐ filed under 37 C.F.R. § 1.34(a)

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Date of Deposit 01/30/01

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Sandra B. Paye

(Typed or printed name of person mailing paper or fee)

Sandra B. Paye  
(Signature of person mailing paper or fee)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	
	)	
Barak, et al.	)	Group Art Unit: Unassigned
	)	
Application No.: Unassigned	)	Examiner: Unassigned
	)	
Filed: January 29, 2001	)	
	)	
For: Methods of Assaying Receptor Activity	)	
and Constructs Useful in Such Methods	)	
(Filed Herewith)	)	

**LETTER TO EXAMINER**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

The application filed herewith is a continuation of application Application No. 09/469,554, filed December 22, 1999, entitled Inhibition of  $\beta$ -arrestin Mediated Effects Prolongs and Potentiates Opioid Receptor-Mediated Analgesia; which is a continuation in part of Application No. 09/233,530, filed January 20, 1999, entitled Methods of Assaying Receptor Activity and Constructs Useful in Such Methods, now U.S. Patent No. 6,110,693, issued August 29, 2000; which is a continuation of Application No. 08/869,568, filed June 5, 1997, entitled Methods of Assaying Receptor Activity and Constructs Useful in Such Methods, now U.S. Patent No. 5,891,646, issued April 6, 1999. Application No. 09/469,554 claims priority to and incorporates by reference in its entirety Application No. 08/869,568, filed June 5, 1997, now issued U. S. Patent No. 5,591,646. For the examiner's convenience, copies of the prior applications are enclosed.

The present application recites the subject matter of Application No. 09/469,554, literally combined with Application No. 08/869,568 (previously incorporated by reference in its entirety). The present application has as its inventors those named in the parent applications, Application No. 09/233,530 and Application No. 08/869,568. The present application has as its drawings those from Application No. 09/469,554 combined with Application No. 08/869,568 (previously incorporated by reference in its entirety).

09/233,530 "013001"

As stated in the MPEP, “[i]nstead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. *The information incorporated is as much a part of the application as filed as if the text was repeated in the application*, and should be treated as part of the text of the application as filed. *Replacing the identified material incorporated by reference with the actual text is not new matter.*” MPEP 2163.07(b) (emphasis added).

Accordingly, no new matter has been added.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: Melissa M. Hayworth  
Melissa M. Hayworth  
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Date: Jan 30, 2001

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Date of Deposit <u>01/30/01</u>
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<u>Sandra B. Paye</u> (Typed or printed name of person mailing paper or fee)
<u>Sandra B. Paye</u> (Signature of person mailing paper or fee)